

SPU



PATENT
Customer No. 22,852
Attorney Docket No. 04329.3133

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Masahiko HASUNUMA, et al.) Group Art Unit: 2811
)
Application No.: 10/653,186) Examiner: KANG, Donghee
)
Filed: September 3, 2003)
)
For: SEMICONDUCTOR DEVICE)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENTS

In response to the Election of Species Requirement mailed August 30, 2004, with a period for response extending through September 30, 2004, Applicants elect as set forth below.

In the Restriction Requirement, the Examiner required restriction under 35 U.S.C. § 121 between ten species, characterized by the Examiner as embodiments 1 - 10, each having a structure as respectively described in one of Figs. 1, 10, 13, 14, 15, 16, 19, 21, 24, and 28.

In response, Applicants provisionally elect to prosecute Species 1, characterized by the Examiner as "Embodiment 1 having a structure as described in Fig. 1" (Office Action, p. 2), **with traverse**, and submit that claims 1 - 5, 7, and 8 are readable thereon.

In order to preserve their Right of Petition, Applicants are traversing this Election of Species Requirement, and "distinctly and specifically" point out the errors in said Requirement. See M.P.E.P. § 818.03. Namely, the Examiner erroneously separated the present invention into

these ten species. Species 2 - 5, as shown in Figs. 10 and 13 - 15, are modified versions of Species 1, shown in Fig. 1, and accordingly do not warrant any additional search of the art.

Applicants note that the second of two criteria for a proper Restriction Requirement requires that there "must be a serious burden on the examiner if restriction is required." *See* M.P.E.P. § 803. Since the Examiner's Election of Species Requirement only delineates eleven species and required election under 37 C.F.R. § 121, it does not make any mention of why it would be a serious burden upon the Examiner to make this Election of Species Requirement in the first place. The Examiner will not have to commence an additional search to examine Applicants' claims. Therefore, the examination of claims 1 - 5, 7, and 8, readable on Species 1 - 5, would not pose a serious burden on the Examiner, and Applicants traverse the Examiner's election of species requirement.

Therefore, this Election and traversal serve as a "writing which distinctly and specifically points out" the errors in the Examiner's Election of Species Requirement. *See* M.P.E.P. § 818.03(a). Furthermore, nothing herein shall be construed as an admission that the claims are not patentably distinct. It is for these reasons that Applicants make their Election of Species, with traverse.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 30, 2004

By: 

David M. Longo
Reg. No. 53,235